## REMARKS

Favorable consideration and allowance are respectfully requested for claims 1 and 3 in view of the foregoing amendments and following remarks.

The Examiner is thanked for the courtesies extended during the interview held January 24, 2007, the substance of which is reflected herein.

The specification was previously amended to recite the priority documents, in the response submitted March 13, 2006. An application data sheet was also provided with this response. Accordingly, the specification is in proper form and no new declaration is required.

The rejection of claims 1 and 3 under 35 U.S.C. § 103(a) over the alleged admissions in the specification and Shank (WO 98/00130) is respectfully traversed.

The present claims are directed to a method that includes the following two steps:

(1) identifying a compound which inhibits de novo lipogenesis in a mammal and

(2) incorporating said compound which inhibits de novo lipogenesis with at least one conventional solid or liquid excipient or at least one conventional pharmaceutical auxiliary substance in a pharmaceutical composition for treating or inhibiting obesity.

The first step, that of identifying a compound which inhibits de novo lipogenesis in a mammal, is achieved by:

(a) measuring at least one candidate compound for inhibition of carboanhydrase activity of at least one mammalian carboanhydrase, and

(b) selecting said candidate compound as a compound which inhibits de novo lipogenesis if said candidate compound exhibits inhibition of carboanhydrase activity of at least one mammalian carboanhydrase.

A proper obviousness rejection of a method claim requires a teaching or suggestion of each and every step in the claimed method. The Shank reference does not teach or suggest every step in the presently claimed method. In particular, the reference does not teach the step of identifying a compound which inhibits de novo lipogenesis in a mammal, and similarly does not teach that this identification is achieved by:

(a) measuring at least one candidate compound for inhibition of carboanhydrase activity of at least one mammalian carboanhydrase, and

(b) selecting said candidate compound as a compound which inhibits de novo lipogenesis if said candidate compound exhibits inhibition of carboanhydrase activity of at least one mammalian carboanhydrase.

Shank is silent as to the de novo lipogenesis inhibiting activity of topiramate and similar compounds, and does not teach or suggest screening for carboanhydrase activity as a way to identify compounds suitable for de novo lipogenesis inhibition. Further, the Shank reference does not teach or suggest incorporating a compound that has been identified using the claimed methodology into a pharmaceutical composition.

The Office Action cites the applicant's specification for the assertion that topiramate acts as a carboanhydrase inhibitor and is suitable for the treatment of obesity. However, the present claims are not directed to a pharmaceutical composition itself. The method includes steps to identify a relevant compound and incorporate that compound into a pharmaceutical composition. Knowledge that topiramate acts as a carboanhydrase inhibitor and is suitable for the treatment of obesity does not address the inventive method of the present claims. Nothing in the specification indicates that such a method was known in the prior art.

Accordingly, Shank, when taken alone, or in combination with knowledge that that topiramate acts as a carboanhydrase inhibitor and is suitable for the treatment of obesity, does not disclose or suggest the presently claimed method. Further, the specification of the present application does not indicate that the presently claimed method was previously known. As such, the obviousness rejection cannot be properly maintained and reconsideration and withdrawal thereof are respectfully requested.

The rejection of claims 1 and 3 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite,is respectfully traversed.

The amendments to claim 1, which delete the objected-to phrase "preparing a pharmaceutical composition . . .", and do not change the scope of the claim, are believed to overcome this part of the rejection.

Claim 1 is also amended to clarify how the step of measuring carboanhydrase activity is correlated to the rest of the method. In particular, the method now clarifies that if the measurement shows inhibition of carboanhydrase activity, the candidate compound is selected as a compound which inhibits de novo lipogenesis.

In claim 1, the phrase "the effect" is deleted and this step of measuring is generally rephrased to provide improved clarity. Accordingly, the antecedent basis issue is rendered moot.

Claim 1 is also amended to clarify the relationship between the at least one candidate compound and the compound of the identifying step. In particular, if the candidate compound exhibits inhibition of carboanhydrase activity of at least one mammalian carboanhydrase, then the candidate compound is selected as a compound which inhibits de novo lipogenesis.

Claim 3 is amended to clarify that the "at least one carboanhydrase" is "at least one mammalian carboanhydrase" referred to in claim 1.

Accordingly, all of the indefiniteness issues identified in the recent Office Action are addressed and reconsideration and withdrawal of this rejection are respectfully requested.

During the interview, the Examiner raised a question about whether the claims are reach through claims. Reach through claims seek to protect something not yet invented. Typically, this is a product or a process of use for a product that is not yet invented. The present claims do not cover products and do not cover methods of using products that are not yet invented. Instead, the present claims are directed to a method that includes the steps of identifying compounds and incorporating identified compounds in a pharmaceutical composition. The claimed method is fully described in the specification which shows that the steps of the method were possessed by the present applicants. A person of skill in the art could readily practice the method based on the present specification. The claim is directed to applicant's inventive method, and not something beyond their invention. Accordingly, the claims do not present a reach through concern.

## CONCLUSION

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket No. 029300.49991D1).

Respectfully submitted,

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